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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,432	12/12/2003	John McKenzie	04445	1431
23688	7590	09/26/2006	EXAMINER	
Bruce E. Harang PO BOX 872735 VANCOUVER, WA 98687-2735			LARSON, JUSTIN MATTHEW	
			ART UNIT	PAPER NUMBER
			3727	

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/707,432

Applicant(s)

MCKENZIE ET AL.

Examiner

Justin M. Larson

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Oath/Declaration

1. An oath or declaration by each actual inventor or inventors listing the entire inventive entity has not been submitted.

As it appears that a party required by 37 CFR 1.48(a)(2) to submit a statement of facts may not be willing to submit such statement, applicant should consider either: a) submission of a petition under 37 CFR 1.183 to waive that requirement if the original named inventor(s) has assigned the entire right and interest to an assignee who has given its consent to the requested inventorship correction, MPEP § 201.03, Statement of Lack of Deceptive Intention, or b) refiling the application (where addition is needed under 37 CFR 1.53(b) with a new oath or declaration and any necessary petition under 37 CFR 1.47, or where only deletion is needed, either under 37 CFR 1.53(b) utilizing a copy of a prior oath or declaration under 37 CFR 1.63(d)(1)(iv), or under 37 CFR 1.53(d))(design applications only), thereby eliminating the need for a 37 CFR 1.48 request.

Applicant is advised to review 37 CFR 1.183, 37 CFR 1.67, 37 CFR 1.48(a), MPEP 409.03 and MPEP 603. Additional help may also be obtained by contacting the Office of Petitions.

Claim Objections

2. Claim 20 is objected to because of the following informalities: Claim 20 as currently presented is said to depend from itself. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 10, and 19, the limitation "storage receptacles, items, and brackets having located thereon at least one prong suitable for inserting into said at least one mounting cavity" renders the claims indefinite because it is unclear how many of these storage receptacles, items, and brackets applicant is attempting to claim. The claims also recite that "at least one of a desired container, item, and bracket" can be secured via the inventive mounting apparatus, implying that Applicant is really only claiming one of either a container/receptacle, item, or bracket. The rejections that follow in this Office Action are based on the assumption that Applicant is really only claiming one of a container/receptacle, item, or bracket having at least one prong/cavity for mounting.

Claim 6 recites the limitation "the one edge" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 20 recites the limitation "its closed position" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 5-11, 14-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Heinz et al. (US 5,769,294 A).

Regarding claims 1, 2, 10, 11, Heinz et al. disclose a device mounting apparatus suitable for attaching and securing items and receptacles having various sizes and

shapes in a vehicle comprising in cooperative combination: a mounting unit (20, Figure 10), that in its closed position is completely hidden from view in an interior surface (26) of a vehicle having located therein a plurality of mounting cavities (hollow areas formed by behind hooks 36); at least one storage receptacle/item/bracket (24) having located thereon a plurality of mounting prongs (multiple hangers have multiple prongs) suitable for inserting into said at least one mounting cavity (Figure 10); thereby allowing the secure attachment of at least one of a desired container/item/bracket (24) in a vehicle.

Regarding claims 5 and 14, the mounting unit rotates around pivot pins (52).

Regarding claims 6 and 15, the pivot pin (52) and its corresponding socket (50) allow for the turning or rotation of the mounting unit, effectively serving as a hinge along the mounting unit's outer edge (Figure 9).

Regarding claims 7 and 16, the cavities are tapered (Figure 12).

Regarding claims 8, 9, 17, and 18, either of the cavities and prongs of Heinz et al. can be considered to be oriented either horizontally or vertically, depending on how you look at the figures.

Regarding claims 19 and 20, the selectively hidden mounting device (20) includes at least one prong (36) and at least one receptacle/container/item (22) has a cavity (opening in the bag handle) for attaching to the prong (Figure 1).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-6, 8-10, 12-15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kempkers (US 4,221,354 A).

Regarding claims 1 and 10, Kempkers discloses a device mounting apparatus suitable for attaching and securing items and receptacles having various sizes and shapes in a vehicle comprising in cooperative combination: a mounting unit (40), that in its closed position is completely hidden from view in an interior surface of a vehicle having located therein at least one mounting cavity (50); at least one storage receptacle/item/bracket (clothing hangers) for inserting into said at least one mounting cavity (col. 2 line 65); thereby allowing the secure attachment of at least one of a desired container/item/bracket (hanger) in a vehicle.

Kempkers does not specifically state that the clothing hangers have prongs, however, Examiner takes Official Notice to the fact that it is old and well known for clothing hangers to have a prong at the top from which the hanger is suspended. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the hangers of Kempkers had prongs.

Regarding claims 3, 4, 12, and 13, Kempkers teaches that the mounting apparatus is made from polycarbonate.

Regarding claims 5 and 14, the mounting unit rotates around a pivot pins (41).

Regarding claims 6 and 15, the pivot pin (41) and its corresponding socket (20', 21') allow for the turning or rotation of the mounting unit, effectively serving as a hinge along the mounting unit's outer edge.

Art Unit: 3727

Regarding claims 8, 9, 17, and 18, either of the cavities and prongs of Kempfers can be considered to be oriented either horizontally or vertically, depending on how you look at the figures.

Double Patenting

9. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

10. Claims 1-6, 8-15, and 17-20 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-6, 8-15, and 17-20 of copending Application No. 10/905,107. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

Art Unit: 3727

double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 7 and 16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/905,107. Although the conflicting claims are not identical, they are not patentably distinct from each other because the prongs of Application No. 10/905,107 are shown to have a tapered shape. While not claimed, one reading the claims would certainly recognize that the claimed prongs had a tapered shape when referring back to the original specification to determine what was meant by the term "prong". Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the prongs of the presently claimed invention with a tapered shape.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571) 272-8649. The examiner can normally be reached on Monday - Thursday, 7am - 5pm.

Art Unit: 3727

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JML
9/12/06


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SUPERVISORY PATENT EXAMINER